

REMARKS

Claims 1-14 were examined and reported in the Office Action. Claims 1-14 are rejected. Claims 1-14 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. In the Drawings

It is asserted in the Office Action that the drawings are objected to under 37 CFR 1.83(a) as the drawing must show every feature of the invention specified in the claims. Applicant has added new Figure 1a that shows the “marker strip being formed integrally with a wall of the bag.” In the replacement drawing sheet and in the specification, no new matter has been entered. The matter illustrated in Figure 1a is supported on page 3, lines 20-23 and 34-37 of the specification as filed. Approval is respectfully requested.

II. 35 U.S.C. § 112

It is asserted in the Office Action that claims 1-14 are rejected under 35 U.S.C. §112 first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has amended the claims to overcome the 35 U.S.C. §112, first paragraph rejection. Applicant respectfully traverses the aforementioned rejection for the following reasons.

In the field of reclosable bags, it is sufficient for an ordinary person skilled in the art to indicate that a strip is formed integrally with a wall of a bag to enable such person to make the strip. This formation of the strip is not technically difficult for an ordinary person skilled in the art. For instance, at column 10, lines 9-12 of US 6,286,999 (a patent in the reclosable bag technical field) also only refers to strips “integrally formed with the respective bag body panels,” which shows that this feature is not technically difficult for

an ordinary person skilled in the art. This indication is sufficient for such a person to be enabled to make the bag.

Accordingly, withdrawal of the 35 U.S.C. §112, first paragraph rejection for claims 1-14 is respectfully requested.

III. Double Patenting

The Office Action rejects the application for double patenting and states that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned. Applicant submits a terminal disclaimer with this response.

Accordingly, withdrawal of the nonstatutory double patenting rejection is respectfully requested.

IV. 35 U.S.C. § 102(a)

It is asserted in the Office Action that claims 1, 2, 6-9 and 12 are rejected under 35 U.S.C. § 102(a), as being clearly anticipated by U. S. Patent No. 6,286,999 issued to Cappel et al. ("Cappel"). Applicant respectfully traverses the aforementioned rejection for the following reasons.

According to MPEP §2131,

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's claim 1 contains the limitations of

[a] A bag having closure strips and a slider, and including a marker strip for preventing manipulation of the slider prior to the marker strip being ruptured, wherein said marker strip is formed integrally with a wall of the bag and includes a single-use adhesive zone designed to fix it in its in-use position on the opposite wall of the bag.

Cappel discloses a bag having closure strips 22, a slider 32, and includes a marker strip 40 for preventing manipulation of the slider prior to the marker strip being ruptured (see Cappel, figures 4a - 4d). Figures 4a – 4d of Cappel, however, do not disclose that marker strip 40 is formed integrally with a wall of the bag and includes a single use adhesive zone designed to fix it in its in-use position on the opposite wall of the bag. In Figures 4a – 4d of Cappel, the marker strip is not formed integrally with a wall of the bag. This is clearly apparent particularly as illustrated in Figures 4c and 4d of Cappel. And further as repeated at column 7, lines 36-38 of Cappel.

Further, in Figures 10a-10d of Cappel, the strip is formed by a sleeve 100, but is not formed integrally with the wall of the bag (see also Cappel, column 9, lines 46-49). Figures 12a-12d and column 10, lines 6-22 of Cappel do not disclose a marker strip 120 formed integrally with a wall of the bag that includes a single-use adhesive zone designed to fix it in its in use position on the opposite wall of the bag. Cappel discloses at column 10, lines 9-12 that only two marker strips 120a and 120b are integrally formed with the respective body panels 12 and 14 of the bag, and detachable therefrom along lines of weakness 122. The tab panels 120a and 120b are attached to each other. Also, at column 10, lines 20-23 of Cappel refers to a single tab panel, but does not disclose that the marker strip is formed integrally with a wall of the bag and includes a single-use adhesive zone designed to fix it on the opposite wall of the bag, as explicitly claimed in claim 1.

Therefore, since Cappel does not disclose, teach or suggest all of Applicant's claim 1 limitations of "said marker strip is formed integrally with a wall of the bag and includes a single-use adhesive zone designed to fix it in its in-use position on the opposite wall of the bag," Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(a) has not been adequately set forth relative to Cappel. Thus,

Applicant's claim 1 is not anticipated by Cappel. Additionally, the claims that directly or indirectly depend on claim 1, namely claims 2, 6-9 and 12, are also not anticipated by Cappel for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 102(a) rejections for claims 1, 2, 6-9 and 12 are respectfully requested.

V. 35 U.S.C. § 103

It is asserted in the Office Action that claims 3, 10, 13 and 14 are rejected in the Office Action under 35 U.S.C. § 103(a), as being unpatentable over Cappel and European Patent Application No. 0941937A1 to Ishizaki ("Ishizaki"). Applicant respectfully traverses the aforementioned rejections for the following reasons.

According to MPEP §2142

[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” “*All words in a claim must be considered* in judging the patentability of that claim against the prior art.” (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claims 3, 10, 13 and 14 either directly or indirectly depend on claim 1. Applicant has addressed Cappel above in section IV regarding claim 1.

Ishizaki discloses a first embodiment where one fixes a seal or a cellophane adhesive tape on both panels of a bag (see Ishizaki, figure 10b). Ishizaki discloses a second embodiment where the marker strip is formed of the flaps fused together (see Ishizaki, column 8, lines 53-55). Ishizaki does not teach, disclose or suggest a marker strip that is formed integrally with a wall of the bag and includes a single-use adhesive zone designed to fix it in its use position on the opposite wall of the bag. It is clear from Ishizaki Figures 10-11 that the seal 8 between the flaps 2a and 3a is not formed integrally with a wall of the bag, it is fixed to both flaps 2a and 3a.

Further, paragraph 0047 of Ishizaki mentions that instead of using a seal 8 or a cellophane adhesive tape, the flaps 2a and 3a may be fused together (see Ishizaki, column 8, lines 53-56). Ishizaki never mentions that the marker strip is formed integrally with a wall of the bag and includes a single-use adhesive zone to fix it on the opposite wall of the bag.

As mentioned above, the first embodiment of Cappel has a marker strip formed of two panels 120a and 120b attached to each other (see Cappel, Figures 12a - 12d), which corresponds approximately to the embodiment of paragraph 0047 of Ishizaki (second embodiment as mentioned above). A second embodiment having a single tab panel, is also contemplated in Cappel (see Cappel, column 10, lines 20-22).

The limitation where the marker strips are formed integrally with a wall of the bag and includes the single-use adhesive zone designed to fix it on the opposite wall of the bag is never disclosed, taught or suggested by either Cappel, Ishizaki, and therefore, nor the combination of the two. From the second embodiment Cappel, an ordinary person skilled in the art will conclude that the marker is integrally formed with the panels 12 and 14 and have no sealing point whatsoever.

Neither Cappel, Ishizaki, and therefore, nor the combination of the two, teach, disclose or suggest the limitations contained in Applicant's claim 1, as listed above. Since neither Cappel, Ishizaki, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over Cappel in view of Ishizaki since a *prima facie* case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claim 1, namely claims 3, 10 and 13-14, would also not be obvious over Cappel in view of Ishizaki for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 3, 10, 13 and 14 are respectfully requested.

CONCLUSION

In view of the foregoing, it is submitted that claims 1-14 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

By: 
Steven Laut, Reg. No. 47,736

Dated: December 21, 2005

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on December 21, 2005.


Jean Svoboda